



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/069,932 | 03/05/2002 | Toyohiro Kobayashi | | 7255 |

7590 01/13/2003

Toyohiro Kobayashi
2 2 11 Sumiredai
Yaizu shi Shizuoka, 425-0053
JAPAN

EXAMINER

MORAN, KATHERINE M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3765

DATE MAILED: 01/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,932

Applicant(s)

KOBAYASHI, TOYOHIRO

Examiner

Katherine M Moran

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to because they include written descriptions of each reference number. The reference numbers are given in the specification and as such, it is not necessary to include additional descriptions in the drawings.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the stopper pin of claim 2 must be shown or the feature canceled from the claim. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The use of the trademark Velcro has been noted in this application, particularly on pg.3, lines 18, 19, and 21. Please check specification for other occurrences. Velcro should be capitalized wherever it appears and be accompanied by the generic terminology, hook and loop.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 2 recites a "stopper pin". This limitation is not recited in the

Art Unit: 3765

specification. Claim 3 recites a "both-sided adhesive". It is assumed that Applicant meant to use the term "hook and loop" and the claim will be treated on the merits as such. Finally, the subject matter of claim 6, as discussed under the 35 U.S. C. 112, 2nd paragraph rejection, is not found in the specification.

5. The disclosure is objected to because of the following informalities: pg.1, line 3: delete "hut" and insert --hat--, line 10: delete "acts" and insert --are--, line 11: delete "puts" and insert --put--, line 15: delete "installed simply" and insert --equipped with--, line 21: insert --on-- after "hair"; pg.11, line 2: delete "hut" and insert --hat--. Also, please revise the Industrial Applicability paragraphs on pgs. 7 and 8. These paragraphs contain idiomatic English and require grammatically correct revisions.

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

Applicant's abstract contains more than 150 words.

Appropriate correction is required.

Claim Objections

7. Claims 1, 3, and 4 are objected to because of the following informalities: claim 1, line 2: delete “made by cloth” and insert --cloth-- after “a”, line 8: delete “(e.g., rear surface)”;

claim 3, line 2: delete “made by cloth” and insert --cloth-- after “a”, line 5: delete “which is a both-sided” and insert --comprising a double-sided--, line 7: delete “(e.g., rear surface)”;

claim 4, line 2: delete “made by cloth” and insert --cloth-- after “a”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, line 10 recites in part “located at least one portion at the connected portion”. It is unclear what is meant by this limitation. Claim 6 is indefinite because the scope of the claim is unclear. What is “other fiber”? It is unclear what is meant by the recitation “other fiber is dried during the cold season and provided to the sunshade cover”. The specification does not serve to further define this recitation.

10. Claim 6 recites the limitation "the water-absorbing material" in line 1. There is insufficient antecedent basis for this limitation in claims 1, 2 or 3.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hujar et al. (Hujar, U.S. 5,557,807) in view of Olajide, Jr. (Olajide, U.S. 5,623,732). Hujar '807 discloses the invention substantially as claimed. Hujar teaches a cap 1 comprising a cloth body, a sunshade cover 23 including a pocket 19 for receiving ice or other coolants. The cover 23 is removably connected to the body by a connecting means 22, and is capable of being stored in the hat body. However, Hujar does not teach a connecting means having an axle. Olajide '732 teaches a cap 10 with a cover 28 connected to the cap by snaps 32,34,36. The snaps include male fasteners secured to the cap and female fasteners secured to the hood 28. The male fastener inherently includes an axle portion for connecting to the female portion. It is well known in the art that various types of fastening mechanisms are functionally equivalent. Hook and loop, button and buttonhole, hook and catch, snaps and adhesive are a few examples. These fasteners may be used interchangeably depending upon the desired aesthetic effect. Therefore, it would have been obvious to one of ordinary skill in the art to substitute hook and loop of Hujar with the axle connecting means as taught by Olajide because this allows for easy displacement of the cover according to the movements of the wearer.

13. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hujar in view of Olajide as applied to claim 1 above, and further in view of Benedict (U.S. 5,956,759).

Art Unit: 3765

Hujar/Olajide discloses the invention substantially as claimed. However, Hujar does not teach cooling material which is a water-absorbing material as a fiber obtained by processing a polymer that contains the sodium salt of polyacrylic acid as a major component, provided to the sunshade cover. Benedict '759 teaches a cap 10 with cooling means 45 composed of a modified acrylic polymer which absorbs large quantities of water, whereby the liquid evaporates to cool the wearer. Further, the specification contains no disclosure of either the critical nature of the claimed polymer or any unexpected results arising from its use, and that as such the claimed polymer is arbitrary and therefore, obvious. Such unsupported material cannot be a basis for patentability since where patentability is said to be based upon the cooling material's composition, the applicant must show that the elements of the cooling material are critical. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the cover of Hujar with the cooling material which is a water-absorbing fiber obtained by processing a polymer that contains the sodium salt of polyacrylic acid as a major component since this is an inexpensive, commercially available composition which can undergo many cycles of adsorption and evaporation without degradation.

14. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Snow (U.S. 4,180,868) in view of Benedict (U.S. 9,956,759). Snow '868 discloses the invention substantially as claimed. Snow teaches a hood comprising a headband 34 with elasticity and a sunshade cover 11 having a cooling material 32 provided at a portion thereof which covers the nape of a wearer's neck when worn. However, Snow does not teach cooling material which is a water-absorbing material as a fiber obtained by processing a polymer that contains the sodium salt of polyacrylic acid as a major component. Benedict '759 teaches a cap 10 with cooling

Art Unit: 3765

means 45 composed of a modified acrylic polymer which absorbs large quantities of water, whereby the liquid evaporates to cool the wearer. Further, the specification contains no disclosure of either the critical nature of the claimed polymer or any unexpected results arising from its use, and that as such the claimed polymer is arbitrary and therefore, obvious. Such unsupported material cannot be a basis for patentability since where patentability is said to be based upon the cooling material's composition, the applicant must show that the elements of the cooling material are critical. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the cooling material of Snow with the cooling material which is a water-absorbing fiber obtained by processing a polymer that contains the sodium salt of polyacrylic acid as a major component since this is an inexpensive, commercially available composition which can undergo many cycles of adsorption and evaporation without degradation.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gifford (U.S. 5,603,120) teaches a curtain attachment for headgear. Simmons et al. (U.S. 5,605,144) teaches a hood with heating packets. Newman, Jr. (U.S. 5,669,074) teaches a removable neckshade for a cap. Gomez (U.S. 5,950,241) teaches a hat with a removably drape. Mangan (U.S. 6,381,750) teaches a curtain attachable to headgear.

Any inquiry concerning this communication or earlier communications should be directed to Examiner Katherine Moran at (703) 305-0452. The examiner can be reached on Monday-Thursday from 8:30 am to 6:00 pm, and alternating Fridays.

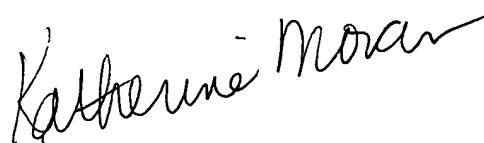
Art Unit: 3765

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert, may be reached at (703) 305-1025. The official fax number for the organization where this application is assigned is (703) 872-9302. The after final fax number for this organization where this application is assigned is (703) 872-9303.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist at (703) 308-1148.

Kmm

January 7, 2003

A handwritten signature in black ink that reads "Katherine Moran". The signature is written in a cursive style with a long horizontal flourish at the end.

Katherine Moran

Examiner, AU 3765